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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,280	10/08/2001	Alex Urich	155696-0034	5788

1622 7590 02/10/2004

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EXAMINER
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LAM, ANN Y

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 02/10/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/973,280

Applicant(s)

URICH, ALEX

Examiner

Ann Y. Lam

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>g</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 11, 12, 15, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Saaski et al., 5,585,011.

As to claims 1 and 11, Saaski et al. discloses a pump (130), and a non-linear flow restrictor (86) coupled to said pump, see Figure 10 or 11, said non-linear flow restrictor maintains an essentially same diameter during a variation in pump pressure.

As to claims 2 and 12, the non-linear flow restrictor changes a direction of fluid flow, see Figure 10 or 11, and see column 30, lines 34-45.

As to claims 5 and 15, the restrictor includes a tube (86) that has a plurality of bends, see Figure 10 or 11.

As to claim 21, Saaski et al. discloses a method comprising creating a flow of fluid that has a pressure and a flowrate, see column 4, lines 12-39; and restricting the flow of fluid so that a variation in the pressure will create a non-linear change in the flowrate while maintaining essentially a same tube diameter, see column 30, lines 34-45.

As to claim 22, Saaski et al. discloses changing a direction of the fluid flow, see column 30, lines 34-45.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6-10, 13, 14, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saaski et al., 5,585,011, in view of Dykes 6,273,894.

Saaski et al. discloses the invention substantially as claimed, except for the pump being a peristaltic or venturi device, and except for a cutting tip. Saaski et al. teaches that the pump may be used for infusion of medication, see column 1, lines 20-47, see column 3, lines 1-4, and teaches that the pump may be a piezoelectric pump, see column 4, lines 24-30. But Saaski also teaches that the described invention is by way of non-limiting example, and that modifications, adaptations and variations apparent to those skilled in the art are within the scope of the disclosure, column 101, lines 4-11.

Dykes discloses a peristaltic or venturi pump as a medical pump, see column 3, lines 37-40. Thus, it would have been obvious to provide a peristaltic or venturi pump in the Saaski device, as known medical pumps.

As to claims 6-10 and 16-20, Saaski et al. teaches that the disclosed pump may be used in fluid handling devices which are capable of continually handling fluids over

an extended period of time, see column 1, lines 36-41. Furthermore, Dykes teaches a device having a fluid pump in addition to a cutting tip (28) for eye surgery, see column 5, lines 49-51, and column 3, lines 37-42. Thus, it would have been obvious to provide in the Saaski et al. medical device, a cutting tip as taught by Dykes for eye surgery.

### ***Response to Arguments***

Applicant's arguments filed November 13, 2003 have been fully considered but they are not persuasive. Applicant argues that the diameter in the Saaski changes with pressure and cites Saaski column 17, lines 11-15.

In response, Examiner would like to emphasize that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Thus, Examiner asserts that even if Applicant's argument is correct that Saaska discloses a change in the diameter of the flow passage, a slight variation in pump pressure would not necessarily change the diameter of the restrictor.

Furthermore, Applicant claims that the "flow restrictor maintains an *essentially* same diameter" (emphasis added.) The "essentially" language encompasses a slight change in diameter.

Moreover, Examiner would like to point out that the citation to which Applicant refers states that "at very high driving pressure differences...." (see column 17, line 12.) Thus, it appears that a low driving pressure would not necessarily result in a change in diameter.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

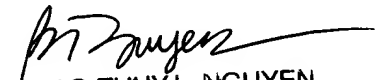
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on M-Sat 11-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703)305-3399. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.L.



BAO-THUY L. NGUYEN  
PRIMARY EXAMINER  
2/9/04